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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,187	03/08/2001	Kazuyuki Yokokawa	67134-5071	4101

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JEFFER, MANGELS, BUTLER & MARMARO, LLP
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EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

MAIL DATE	DELIVERY MODE
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05/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/801,187	Applicant(s) YOKOKAWA, KAZUYUKI	
	Examiner Nasser Ahmad	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 181-186, 188-194, 197-212, 214-234, 236-254 and 256-271 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 181-186, 188-194, 197-212, 214-234, 236-254 and 256-271 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/21/2007 has been entered.

Rejection Withdrawn

2. Claims 181-222 (typographical error has been corrected) are rejected under 35 U.S.C. 102(e) as being anticipated by Mihara (6380132) made in the Office Action of 2/9/2006 has been withdrawn in view of the amendment 2/21/2007.

3. Claim 187 is rejected under 35 U.S.C. 112, second paragraph, made in the Office Action of 2/9/2006 has been withdrawn in view of the amendment 2/21/2007.

4. Claims 223-264 are rejected under 35 U.S.C. 102(e) as being anticipated by Mihara (6380132) made in the Office Action of 2/9/2006 has been withdrawn in view of the amendment 2/21/2007.

Response to Arguments

5. Applicant's arguments with respect to claims 181-186, 188-194, 197-212, 214-234, 236-254, 256-271 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 265-268 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 265-268, the phrase "has no internal release surface" is found to unsupported by the specification, as originally filed, because the negative language is not disclosed in the specification. Hence, this phrase is found to be new matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 181-186, 188-194, 197-212, 214-234, 236-264, 269-271 are rejected under 35 U.S.C. 102(e) as being anticipated by Mihara (6380132).

Mihara relates to a multilayered sheet structure (1) comprising a first layer (7) and a second layer (5). Figure-8 shows four continuous cut lines (2) that intersect to form a rectangular shape with opposite parallel cut line pairs being perpendicular to each other. The cut lines cut completely through the first layer (figure-9) but not entirely through the thickness of the multilayered sheet (figure-2). The drawing also shows a lower bottom-most surface and a top upper-most surface.

The phrase "being constructed and adapted to cause...only once" has not been given any patentable weight because said phrase is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchinson, 69 USPQ 138.

Figure-8 shows the presence of an image on the sheet.

Figure-5 shows the cut line configured by their depth, groove width and shape.

Figure-5 also shows an adhesive layer (6) between the first layer and the second layer.

The release liner (5) can be of paper such as poly-laminated paper (col. 6, lines 11-13).

The perimeter edge of the sheet forms a portion of one sheet portions (figure-1D).

The sheet is photo-receptive (8).

The first layer can be a film and the second layer can be a poly-laminated paper (col. 7,

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lines 49-52).

The cut lines are die-cut lines (3).

The second layer can a resin film (col. 6, lines 11-13).

A fifth cut line is provided as the cut line for the second cut portion as shown in figure-8.

The intended use phrases such as "can be bent", "when separated", "being structurally capable of causing", etc. have not been given patentable weight because said phrases are deemed to be of positive limitations.

As for claims 269-271, figure-1A of Mihara shows that the layers are coextensive with one another.

Response to Arguments

10. Applicant's arguments filed 2/21/2007 have been fully considered but they are not persuasive.

In response to applicants' arguments that the "functional" or "intended use" clauses such as "constructed and structurally capable", "structurally capable" etc. cannot be ignored, applicant is informed that said phrases are not positive limitations to the claimed structure as it only requires the ability to so perform. Contrary to applicant's position, said phrases were not ignored but, because said phrase are not positive recitation of the claimed invention, said phrases does not affect the structure of the claimed product.

It is also noted that the phrase "configured and constructed" was not found to of intended use, unless it is combined with intended use language.

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Applicant is informed that the instant claimed invention is directed to a product structure and the intended use phrases are not positive limitation to the claimed product as they are directed to a method of using the product.

The Declaration by Dr. Ugolick is only directed to the method of using the product language and fails to distinguish the instant claimed product from the prior art.

As applicant's position that *If the examiner contends that the Mihara et al. release sheet would break (split) when folded, he is requested to provide evidence, such as examiner's affidavit, which supports that contention*, this is not deemed to be persuasive because it is not germane to the issue at bar. It should be noted the phrases such as "when folded" is directed to a future use of the claimed product.

Declaration

11. The declaration by Dr. Ronald Ugolick on 2/21/2007 has been considered but is found to be ineffective to overcome the prior art of Mihara because paragraph-7 is directed to intended use recitation phrases such as "adapated to cause...when ...is bent" as explained hereinbefore.

Similarly, in paragrph-8, the argued phrase is " can be bent...portions" is directed to intended future use of the claimed product.

For paragraph-9, the phrase "capable of causing...when...is bent" is intended use language as explained hereinabove.

For paragraphs 10 and 11, the hereinabove explanations apply *a fortiori* herein.

As for paragrsp-12, the negative language in claims 265-268 is found to be new matter for lack of support in the originally filed application.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Nasser Ahmad 4/30/07
Primary Examiner
Art Unit 1772

N. Ahmad.
April 30, 2007.